

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: ) Art Unit: 1644  
CLASSEN, John Barthelow )  
Serial No.: 08/591,651 ) Examiner: GAMBEL, P.  
Filed: February 12, 1996 ) Washington, D.C.  
For: METHOD AND COMPOSITION ) January 31, 2013  
FOR AN EARLY VACCINE TO )  
PROTECT AGAINST BOTH... ) Docket No.: CLASSEN=1A  
Confirmation No.: 9417

REQUEST FOR SUSPENSION UNDER 37 CFR 1.103 (a)

U.S. Patent and Trademark Office  
Customer Service Window  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

S i r :

Pursuant to 37 CFR 1.03(a), Applicant hereby requests suspension of action for six months.

This request is timely as no reply to an office action is outstanding (applicant replied to the last action, that of September 25, 2011, on March 12, 2012).

The fee of \$200.00 (1.17(g)) is efiled by credit card charge herewith. Please charge any deficiency in the fee, or credit any overpayment, to Deposit Account 02-4035, with notice to the undersigned.

Good and sufficient cause exists for the requested suspension of action.

As the Examiner is aware, three patents belonging to the same patent family were litigated in Classen Immunotherapies Inc. v. Biogen, Inc. See e.g. reference KE, the Petition for Writ of Certiorari filed May 11, 2009, and reference KF, the resubmitted petition, listed in the IDS list attached to the last office action. See also Classen Immunotherapies Inc. v. Biogen IDEC, 100 USPQ2d 1492 (Fed. Cir., August 31, 2011), which reversed the district court's holding of ineligibility for patent under §101 as to the '139 and '739 patents, and affirmed it as to the '283 patent, and remanded the case to

the district court for appropriate further proceedings.

Subsequently, in September, 2012, three inter partes reexamination requests were filed against those three patents respectively:

95/002,008 (vs. '139 patent)

95/002,182 (vs. '790 patent)

95/002,224 (vs. '739 patent).

Inter partes reexamination was subsequently ordered in all three cases and is ongoing. For example, a petition to strike the patent owner's December 26, 2012 response and comments by the third party requester on that response were served January 24, 2013 in 95/002,182.

It may reasonably be expected that in these three inter partes reexamination proceedings, the PTO will be considering a variety of issues, some of which may have bearing on the instant application.

It would not be an efficient use of PTO resources to engage in active prosecution of this case while any of the three inter partes reexamination proceedings are still pending. If applicant prevails on an issue in those proceedings, the PTO might no longer see a need to raise it against this application. Contrariwise, if the third party requester prevails on an issue in those proceedings that is relevant herein, Classen might amend his claims to moot the issue, or even decide to abandon the instant application.

Likewise, suspension is appropriate for relieving the burden on Classen. The assignee "Classen Immunotherapies" is a one man company, and Dr. Classen must already prosecute the three inter partes reexamination proceedings according to the unforgiving timetable for such proceedings. The third party requester is a large company with far greater resources. Suspension does not liberate Dr. Classen from the need to establish the patentability of his claims, but it does permit him to prioritize his limited resources.

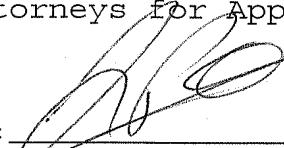
The contemplated suspension may be analogized to the automatic suspension of a reissue application when there is an indication of concurrent litigation. See MPEP 1442.02. This is done to avoid "duplication of effort". The requested suspension has the same goal.

Applicant notes that it is evident that the pace of office action in this case has been mindful of the litigation on the three related Classen patents. Thus, the last office action was mailed September 15, 2011, just two weeks after the last Federal Circuit decision (August 31, 2011), and that was two years after Applicant's last response (September 21, 2009). Thus, we believe that the requested suspension is in effect formalizing what the PTO has been doing informally already, that is, avoiding duplication of effort. And duplication of effort between this proceeding and three inter partes reexaminations is as undesirable as duplication between this proceeding and the equally related litigation.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicant

By:

  
Iver P. Cooper  
Reg. No. 28,005

1625 K Street, N.W.  
Washington, D.C. 20006  
Telephone: (202) 628-5197  
Facsimile: (202) 737-3528  
IPC:lms  
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